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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/170,864	10/13/1998	ROY I. EDENSON	TI-25667	7234

23494 7590 09/22/2004

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EXAMINER
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ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/170,864

Applicant(s)

EDENSON ET AL

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 21-40 and 43-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 25-40 and 43-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office action is in response to Applicant's Petition to withdraw finality of rejection under 37 CFR 1.181, file 08/06/2004. The reason for this delegation is that the points raised in the petition are agreed with and the relief requested is granted in full. Therefore, a new final rejection is provided because of Applicant's newly added claims 43-53.

2. Claims 20, 41-42 are canceled, claims 43-53 are added, and claims 1-19, 21-40 and 43-53 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 25-40 are rejected under 35 U.S.C. 102 (b) as being patentable by Pickholtz (U.S. Pat. No. 4,593,353).**

**As per claims 25-40, Pickholtz** discloses a method/apparatus for limiting program execution to only an authorized data processing system, a proprietary program, together with first and second authorization codes, is stored on a magnetic

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disc or other storage medium(which is readable as Applicant's claimed invention wherein it is stated that a secure data storage medium), comprising:

a digital storage medium for storing digital data (see., abstract, col 2, lines 26-42, specifically wherein it is stated that magnetic disc or other storage); and

an identification system module corresponding to the digital storage medium, the identification system module containing an authorization code describing which media players are authorized to read digital data from the digital storage medium (see., abstract, col 2, lines 26-42, col 3, lines 1-36, specifically wherein it is stated that a hardware module containing a pseudorandom number generator unique to the authorized system receives the first authorization code as a key, and the step of describing which media players are authorized is interpreted as wherein said if there is a favorable comparison, an execute enable signal is generated to enable the software to be executed in the system or in the media players).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 43-53 are rejected under 35 U.S.C. 102 (b) as being patentable by Kurland et al. (U.S. Pat. No. 4,117,605).**

**As per claims 43-53, Kurland** discloses a conversational type response to an interrogatory message from a removably insertable magnetic storage medium which comprises a plurality of coextensive multipurpose audio tracks contained in a housing includes a multipurpose selection for directly selecting one of the tracks for reproducing the selected information stored thereon. The storage medium housing having a playback authorization code disposed thereon (which is readable as Applicant's claimed invention wherein it is stated that a secure data storage medium), comprising:  
a digital storage medium for storing digital data (see., abstract, col 1, lines 58-68, col 2, lines 1-37, col 3, lines 1-68, col 4, lines 1-68); and  
an identification system module corresponding to the digital storage medium, said identification system module containing an authorization code, said authorization code operable to authorize certain media players to read said digital data when an identifier code in said media players matches said authorization code (see., abstract, col 1, lines 58-68, col 2, lines 1-37, col 3, lines 1-68, col 4, lines 1-68, col 7, lines 53-68, col 8, lines 1-68).

## RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 1/21/2004 have been fully considered but they are moot in view of new ground (s) of rejection. Necessitated by amendment (Applicant's newly added claims 43-53).

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**REMARKS**

7. In response to claims 25-40, Applicant argues that the prior art of record taken alone or in combination fails to disclose: " identification system module containing an authorization code describing which media players are authorized to read digital data from the digital storage medium". As indicated above, Pickholtz discloses this limitations in the abstract, col 2, lines 26-42, col 3, lines 1-36, specifically wherein it is stated that a hardware module containing a pseudorandom number generator unique to the authorized system receives the first authorization code as a key, and the step of describing which media players are authorized is interpreted as wherein said if there is a favorable comparison, an execute enable signal is generated to enable the software to be executed in the system or in the media players.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

September 01, 2004